

Application No.: 09/476,334
Amendment Under 37 C.F.R. §1.111 dated September 27, 2004
Reply to the Office Action dated May 27, 2004

REMARKS

Claims 1 – 87 were canceled without prejudice or disclaimer of the subject matter recited therein. New claims 118 – 121 were added. Therefore, claims 88 – 121 are now pending in the present application. The rejections set forth in the Office Action are respectfully traversed below.

Allowable Subject Matter

Applicants gratefully acknowledge the indication in item 10 of the Action that claims 99, 100, and 111 – 113 were merely objected to as being dependent upon a rejected base claim, but are otherwise allowable. Claims 92 – 96 were merely rejected under double patenting rejections, but are allowable over the prior art of record. In addition, Applicants gratefully acknowledge the indication in item 11 of the Action that claims 108, 109, 114 and 115 include allowable subject matter.

Rejections Under 35 U.S.C. §103

Claims 88 -91, 97, 98, 101-107, and 117 were rejected under 35 U.S.C. §103 over **Hamilton et al.** (USP 5,504,816) in view of **Choudhury et al.** (USP 5,509,074).

The Office Action correctly indicated that **Hamilton** “fails to explicitly disclose that the encrypted data is being decrypted using the first secret key *when the encrypted data is displayed.*” The Office Action makes the further reference to **Choudhury** for disclosing this missing feature.

However, **Choudhury** describes decrypting encrypted data for display or printing only at the end of a distribution sequence. Only the targeted end user(s) and/or the designated target display or printing “agents” actually decrypt encrypted information for display/printing. Nothing in **Choudhury** teaches or suggests any need to re-encrypt decrypted/displayed information.

In comparison, **Hamilton** discloses decryption/re-encryption only at intermediary destinations (such as at a cable network’s headend that receives the satellite transmission). There is no teaching or suggestion in either **Choudhury** or **Hamilton**, either alone or in combination, to modify the teachings of **Hamilton** to insert the feature for decrypting encrypted data for display, prior to re-encryption.

On the contrary, **Hamilton** actually emphasizes decryption and re-encryption of a signal “*without decompressing* the data, video and/or audio information being transmitted.” (See e.g. column 2, lines 4 – 6; and column 7, lines 43 – 45). Display is not possible without decompressing the data, video, and/or audio information. Contrary to the suggested modifications set forth in the Office Action, such disclosures of **Hamilton** actually *teach away* from decrypting encrypted data for display and then re-encrypting the *displayed* data using a second secret-key.

For at least these reasons, the present claimed invention patentably distinguishes over the prior art. New claims 118-121 recite features similar to claims 88-91 and therefore, also distinguish over the prior art for at least the reasons as discussed above.

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Claims 110 and 116 were rejected under 35 U.S.C. §103 over **Choudhury** in view of **Hamilton**. However, **Choudhury** does not teach or suggest transferring a second secret-key for re-encrypting both the decrypted data *and a copyright management program* to the primary user terminal via the communication network. In contrast, **Choudhury** describes the display/printing agent having “software trusted by publisher which decrypts and displays the document obtained from document server.” (Column 3, lines 43 – 45). In other words, nothing in **Choudhury** teaches or suggests, either alone or in combination with **Hamilton**, any re-encryption of any copyright management program. The target/display printing agent of **Choudhury** has special purpose software/hardware for decrypting documents for display. *There is no copyright management program that is re-encrypted.* Indeed, the Office Action states that **Choudhury** does not disclose any second secret-key used for re-encrypting.

The further reference to **Hamilton** for its teachings regarding re-encryption also do not address the use of a second secret key for re-encrypting both decrypted data, *as well as a copyright management program.*

For at least these reasons, nothing in the prior art, either alone or in combination, teaches or suggests all the features recited in the present claimed invention of claim 110 and 116.

Double Patenting Rejections

Claims 88 – 96, 98, 106, 107, 110 and 116 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of USP 5,646,999, in view of **Choudhury**, as well as over claim 1 of USP 6,097,818 in view of **Choudhury**.

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In making the double patenting rejections, the Office Action relied on the allegation that certain claimed elements were “not needed.” On the contrary, claim 1 of both the ’818 and ’999 patents includes numerous claimed elements and features that cannot be casually disregarded as being “not needed.”

For example, the numerous features recited in claim 1 of the ’818 patent directed to the handling of edited data and the creation of new data are part of the claimed invention that resulted in the patentability of that claim. Likewise, claim 1 of the ’999 patent recite numerous features regarding editing of data and the creation of new data that are part of the patentability of that claim. Such features do not constitute elements whose functions are not needed and that can be simply disregarded as being obvious. For at least these reasons, the double patenting rejections should be withdrawn.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant’s undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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The Commission is authorized to charge Deposit Account No. 50-2866 for any fee which is deemed by the Patent and Trademark Office to be required to effect consideration of this statement.

Respectfully Submitted,

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